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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
1751	18

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/350,579

Applicant(s)

LANG ET AL.

Examiner

Margaret Einsmann

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 June 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-68,70-74,76,77,79-106,108 and 109 is/are pending in the application.

4a) Of the above claim(s) 6,9-13,32-61 and 84-106 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-5,7,8,14-31,62-68,70-74,76,77,79-83,108 and 109 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

6) Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/17/2002 has been entered.

Applicant's remarks filed 6/17/02 have been carefully considered. No claims have been amended or canceled in this response.

The Declaration of Lang and Cotteret under 37 USC 1.131 is persuasive that the claimed invention, using a dye within the scope of the claimed dyestuffs I combined with a nonionic amphiphilic polymer, was reduced to practice prior to May 8, 1998. Accordingly, the Jones reference may not be used as prior art and the rejection of Claims 1-5, 7-8, 14-31, 62-83 and 107 under 35 U.S.C. 103(a) as being unpatentable Jones in view of Rondeau is withdrawn.

35 U.S.C. 103(a) Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter

as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5, 7-8, 14-31, 62-68, 70-74, 76, 77, 79-83, 108 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over de la Mettrie in view of Rondeau.

De la Mettrie, U.S. Patent No. 6,010542, teaches hair dyeing compositions which contain oxidation dye precursors, optional couplers, and at least one nonionic amphiphilic polymer containing a fatty chain and a hydrophilic unit as claimed, see Abstract. The dye precursors and couplers include those as claimed, and may be present in the claimed amounts, see col. 4, line 6-col. 7, line 28. De la Mettrie teaches that the compositions may also contain direct dyes in order to enrich the shades with glints, including azo dyes, see col. 7, lines 29-33. The oxidizing agents include those as claimed, see col. 8, lines 34-38. The nonionic amphiphilic polymer is preferably

selected from a group which includes the various nonionic amphiphilic polymers as claimed, wherein the polymer may be present in the claimed amounts, see col. 3, line 22-col. 4, line 5. De la Mettrie teaches that the compositions may also contain other conventional additives, and that the compositions have pH's as claimed, see col. 8, lines 13-33 and 43-46. De la Mettrie exemplifies a composition which contain a nonionic amphiphilic polymer, oxidation bases, coupler and oxidant in an aqueous medium as claimed, see Example 1. De la Mettrie does not teach the specifically claimed cationic direct dyes.

Rondeau is relied above as teaching that the addition of the claimed cationic direct dyes of formula (I) to compositions for dyeing hair which contain at least one oxidation base, at least one coupler, and at least one oxidizing agent which may be the same as those present in de la Mettrie's compositions, results in various improvements over conventionally used direct dyes such as rich glints and good endurance properties. Rondeau is also relied upon as suggesting that the claimed direct dyes are compatible with de la Mettrie's nonionic polymers. Rondeau teaches that the cationic dyes should be used in the claimed amounts, see col. 9, lines 36-42.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a direct dye as claimed in the claimed amounts to the compositions of de la Mettrie, which contain oxidation bases, couplers, oxidants and nonionic amphiphilic polymers as claimed, because de la Mettrie teaches that direct dyes, including azo dyes, may be used in admixture with the patentee's oxidation dyes, and Rondeau teaches that the claimed cationic direct azo dyes result in improved

endurance and glints when added to oxidative hair dyeing compositions in the claimed amounts, absent a showing otherwise. Furthermore, de la Mettrie's compositions may contain the same mixtures of oxidation bases and couplers taught by Rondeau, and Rondeau teaches that the direct dyes are compatible with nonionic polymers (de la Mettrie's required additives).

Response to Arguments

3. Applicant's arguments filed 6/17/2002 have been fully considered but they are not persuasive regarding the above rejection. Accordingly the rejection is maintained. Basically, applicant is arguing that the examiner made an improper combinations of the references. Applicant argues that de la Mettrie does not teach the cationic direct dyes as claimed. He does not need to. Rondeau provides for that deficiency. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*,

443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In conclusion, both references are concerned with the art of oxidative hair dyeing; both of the references teach additives to oxidative hair dyeing compositions; de la Mettrie teaches the benefits of adding the disclosed polymer to compositions for oxidative dyeing of hair, making it *prima facie* obvious to combine the polymer of de la Mettrie with the direct cationic dyes in the same composition. Applicant states that some desirable reason must exist to add the particular cationic dyes of Rondeau to the compositions of de la Mettrie comprising a nonionic amphiphilic polymer. Applicant states that Rondeau never teaches that the cationic dyes themselves make it possible to obtain radiant colorations that are rich in glints while at the same time have good endurance properties.

Applicant argues that Rondeau never teaches that the claimed cationic direct dyes result in both rich glints and good endurance properties in oxidative hair dyeing compositions. On the contrary, Rondeau states in col 1 lines 40 et seq that to "vary the shades obtained further and to give them glints, it is possible to use, in combination with oxidation hair precursors and the couplers, direct dyes, i.e., colored substances which provide coloration in the absence of an oxidizing agent. Rondeau further continues, "The great majority of direct dyes belong to the family of nitrobenzene compounds and have the drawback, when they are incorporated into dye compositions, of leading to colorations that have insufficient endurance, i.e., fastness, in particular with respect to shampoos." Accordingly Rondeau's direct dyes are improvements over the known direct dyes. This alone is sufficient motivation to use them in the compositions of de la

Mettrie as the azo direct dye disclosed. Rondeau uses them in combination with any oxidation base and a substituted m-phenylenediamine coupler. Said oxidation bases and m-phenylenediamine couplers are taught to be used in the oxidative hair dyeing compositions of de la Mettrie. See col 7 line 1 and lines 12-14.. Accordingly, we have a teaching that:

- a. direct dyes are conventionally added to oxidative hair dyeing compositions to vary the shades and add glints.
- b. the known direct nitrobenzene dyes have problems with fastness, especially to shampoo
- c. Rondeau has found that his cationic direct dyes in combination with an oxidation base and m-phenylenediamine coupler provides improved endurance and glints.
- d. The same composition of oxidation base and m-phenyleneamine couplers are taught for use in the hair dyeing compositions of de la Mettrie as are used in Rondeau.
- e. One would be motivated to add the direct dye of Rondeau to the oxidation base and m-phenylenediamine of de la Mettrie so that one would obtain hair dye compositions of varying shades and glints which have good endurance properties as stated on lines 60-64 col 1 of Rondeau.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claim 1 be found allowable, claims 2 and 3 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

There is no difference in scope between these three claims. The claimed compositions are exactly the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 703-308-3826. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Margaret Einsmann
Margaret Einsmann
Primary Examiner
Art Unit 1751

August 12, 2002